



<b>TRANSMITTAL FORM</b> <small>(to be used for all correspondence after initial filing)</small>	Application Number	09/776,147	
	Filing Date	02/05/2001	
	First Named Inventor	Palmway-Riley, G. W.	
	Art Unit	3643	
	Examiner Name	David J Parsley	
Total Number of Pages in This Submission	15	Attorney Docket Number	

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**PATENT**  
**TC 3600**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No.: 09/776,147  
Filing Date: 02/05/2001  
Applicant: Palmway-Riley, Glenn W.  
Group Art Unit: 3643  
Examiner: David J Parsley  
Title: Fishing hooks and lures

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Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**SUPPLEMENTAL APPEAL BRIEF**

Sir:

Request is hereby made for reinstatement of the Appeal.

Further to the Office Action Summary dated 10/21/2003 of Appeal Brief filed 07/24/2003 , please consider the arguments and remarks set forth below.

Attachments:

Appendix - Appealed Claims

**RECEIVED**  
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**GROUP 3**

**SUPPLEMENTAL APPEAL BRIEF**  
**TC 3600**

*Real party in interest* - The *pro se* applicant named in the caption of the brief in relation to application 09/776,147, a U.S. Citizen resident overseas, is a small entity not represented by a registered practitioner.

*Related appeals and interferences* - The claimed invention is under examination in the country of Australia Patent Application No. 18289/01.

*Status of claims* - Claims 1 thru 22 have been rejected, canceled and/or withdrawn.  
Claims 23 and 24 are pending and are claims appealed.

*Status of amendments* - Claims 23 and 24 are the amendments entered subsequent to final rejection by direction of the Examiner.

*Summary of invention* - Referring to US2001/0015028A1 page 1 [ ], and FIG. 1 ( ). The invention as claimed is a fish hook or lure [column 1, 0004 and 0007, column 2, 0013] comprising a body (1) composed of a metal which is exposed for contact with water [column 1, 0006], a winding (3) of metal [column 1, 0006], said winding having a central opening with said body being within the central opening such that the winding extends around the body in multiple turns to form a coil [column 1, 0011], the metal of said winding being exposed for contact with water [column 1, 0006], and a nonconductive insulating layer (2) between the winding and the body [column 2, claim 1b and 6b] to insulate the winding from direct contact with the body [column 1, 0006 and 0008], wherein the winding and the body are of dissimilar metals [column 1, 0008] such that immersion of the hook in water results in the generation of a fish-attracting electromagnetic field as a result of electrolytic action between the two metals [column 1, 0008].

*Issues* - Application for Patent has been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 2,384,993 to Goddard et al. Impermissible hindsight and improper 'obvious to try' reasoning in examination fails to acknowledge greater than expected results of the inventive step through erroneous interpretation of the prior art which includes disclosures that teach away from the claimed invention and would render the prior art unsatisfactory for its intended purpose with no reasonable expectation of success. Contrary to 35 U.S.C. 103(a), patentability has been negated by manner in which the invention was made.

*Grouping of claims* - Within judgment of obviousness the claims stand together.

*Argument -*

The appealed application has been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2,384,993 to Goddard et al.

In the office action dated 01/14/03 pg. 2 the Examiner erroneously states that Goddard et al. discloses a winding-12 of 'fine color'. Referring to U.S. Patent No. 2,384,993 to Goddard et al., Goddard does disclose a winding of a bright color (column 1 line 15) and of a different color to that of the body (column 2 line 15) and it would be obvious to one skilled in the art that the best method to preserve a bright color in a corrosive environment would be to coat the winding, to insure a long-lasting contrast to the body-10. Goddard et al. also discloses a fine metal strip (columns 1 and 2 line 14) as a winding and it would be obvious to one skilled in the art that fine would suggest delicacy and flexibility to suit its inherent use (i.e. a means of direct attachment to the hook). Goddard further discloses a strip as the preferred winding which is contrary to the invention now claimed and fails to expressly or impliedly suggest the claimed invention. Referring to the Merriam-Webster's Collegiate Dictionary 'strip' is defined as 'a long narrow piece of a material' and it would be obvious to one skilled in the art that such a material would not be an appropriate material to form a wire coil.

Furthermore as the color and buoyancy of the body-10 of Goddard is essential to the functionality of the disclosed invention (column 1 lines 15 and 16), and the disclosed invention suggests the preferred embodiment of the winding-12 as 'having spaced coils and being of a different color to that of the body-forming mass-10' (column 2 lines 14 and 15) the proposed obviousness would render the prior art invention being modified unsatisfactory for its intended purpose, and thus there is no suggestion or motivation to make the proposed modification.

Further, the office action utilizes impermissible hindsight by applying an improper 'obvious to try' rationale in relation to the winding-12, and the hook-6 in Goddard et al. by suggesting that the winding disclosed by Goddard would likely be composed of stainless steel while it is commonly known by those in the art that quality fish hooks are often composed of stainless steel and thus the disclosure of the pending application of dissimilar conductors isolated by a nonconductive insulation layer is in no way rendered obvious. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. Inherency may not be established by probabilities or possibilities where the prior art gives no indication of which parameters are critical and no direction is suggested or implied as to which of many possible choices is likely to be successful. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish obviousness, and the level of skill in the art cannot be relied upon to provide the suggestion to combine references and negative the inventive step and the resulting superior properties over the prior art.

In the recent Office Action dated 10/21/2003 the Examiner further erroneously implies that the body-forming mass-10 of Goddard et al. serves as a nonconductive insulation layer. Goddard does disclose a material (column 2 lines 6 through 8) composed of a filamentous substance desirably of a bright color and in which the hook is rendered buoyant (column 1 lines 15 and 16). Referring to the Merriam-Webster's Collegiate Dictionary 'filamentous' would suggest a noncombustible conductor as the preferred embodiment of the invention and therefor the disclosure in Goddard in no way suggests the currently appealed claims and in fact includes disclosure that both teach away from the appealed claims and offers no reasonable chance for success.

Goddard et al. Fig 1 and Fig 4 clearly show the winding-12 and the hook-6 directly adjacent to each other and reflects that the prior art in its entirety fails to disclose, suggest, teach or otherwise imply that the body-10 is a nonconductive insulating layer as disclosed in the current application. Therefore, the *prima facie* case can be rebutted by evidence showing that the prior art does not necessarily possess the characteristics of the pending claims and as a whole includes disclosures that teach away from the currently claimed invention.

To support a rejection under 35 U.S.C. § 103, the collective teachings of the prior art must have suggested to one of ordinary skill in the art that, at the time the invention was made, the applicants claimed invention would have been obvious. Motivation to make or use the non-obvious product must be present in the prior art. Obviousness cannot be predicated on what is not known at the time an invention is made even if the inherency of a certain feature is later established.

The Examiner further argues the generation of electromagnetic fields by dissimilar metals is obvious through the prior art. It is commonly known by those of ordinary skill in the art that conductive mediums placed in an electrolyte will produce an elementary electromagnetic field, however none of the prior art relied upon teaches or renders obvious the relationship of winding and core in the production of an enhanced electromagnetic field to attract fish as in the current application. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

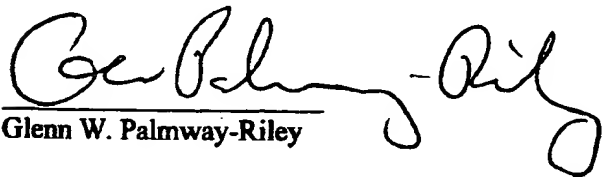
In contrast U.S. Patent No. 4,218,975 to Ream discloses a toroidal coil to create 'an output voltage' as a means for detecting electromagnetic fields and for firing or controlling an ordinance device and in no way renders obvious the currently claimed invention.

In contrast U.S. Patent No. 6,247,261 to Kechriotis discloses an electromagnetic field as the result of galvanic reaction upon a linearly oriented cathode-anode arrangement of metals and similarly fails to teach or render obvious the currently claimed invention.

In contrast U.S. Patent No. 4,970,808 to Massie discloses an electro-acoustical fishing lure from colliding electrodes and similarly fails to teach or render obvious the currently claimed invention.

None of the prior art made of record and not relied upon teaches or renders obvious the claimed invention of the body of exposed metal, the exposed winding disposed around the body and insulated therefrom, with the winding and body being formed from dissimilar metals so as to generate an enhanced electromagnetic field by electrolytic action when the winding and body are exposed to contact with water when immersed therein.

Respectfully submitted  
January 5, 2004

  
Glenn W. Palmway-Riley

## **APPENDIX**

*Copy of the claims involved in the appeal -*

23. A fishing hook comprising a body composed of a metal which is exposed for contact with water, a winding of metal, said winding having a central opening with said body being within the central opening such that the winding extends around the body in multiple turns to form a coil, the metal of said winding being exposed for contact with water, and a nonconductive insulating layer between the winding and the body to insulate the winding from direct contact with the body, wherein the winding and the body are of dissimilar metals such that immersion of the hook in water results in the generation of a fish-attracting electromagnetic field as a result of electrolytic action between the two metals.

24. A fishing hook according to claim 23 wherein the body comprises a rectilinear part having at one end means for attachment of a line and at the other end a hook, wherein the winding is applied to the rectilinear part of the body.